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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,462	10/31/2003	Jay S. Walker	97-007-C1	4855

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EXAMINER	
PRESTON, JOHN O	

ART UNIT	PAPER NUMBER
3691	

MAIL DATE	DELIVERY MODE
05/11/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/699,462	WALKER ET AL.	
	Examiner	Art Unit	
	JOHN O. PRESTON	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 February 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,63-72,75 and 76* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,63-72,75 and 76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 25, 2010 has been entered.

DETAILED ACTION

2. Claims 1, 63-72, 75, and 76 are presented for examination. Applicant filed an amendment on September 25, 2010. Claims 73-74 were canceled. Claims 1, 68, 72, 75, and 76 were amended. Examiner withdraws the previous office action and establishes new grounds of rejection for claims 1, 63-72, 75, and 76. The rejection of claims 1, 63-72, 75, and 76 is a non-final rejection of the claim(s).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,694,300. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed towards a method comprising: receiving from a first merchant an indication of a purchase having an associated purchase price and at least one purchase parameter; determining, by a central controller, an upsell from a second merchant to offer to the customer based on the at least one purchase parameter, upsell having associated therewith an upsell price; performing, by the central controller, a comparison to establish whether a credit account of the customer may be charged the upsell price; transmitting a product identifier for specifying upsell; receiving a selection signal indicative of whether indicating that the supplementary product upsell is accepted; and charging the upsell price to the credit account of the customer, the upsell price being in addition to the purchase price.

Response to Arguments

5. Applicant's arguments filed February 10, 2011 have been fully considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 63, 75, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach (5,434,394) in view of Deaton (5,621,812).

Claim 1**:** Roach discloses the following limitation(s):

- receiving from a first merchant an indication of a purchase having an associated purchase price and at least one purchase parameter; (Roach: col 5, lines 64-67)
- performing, by the central controller, a comparison to establish whether a credit account of the customer may be charged the upsell price; (Roach: col 2, lines 47-50; col 4, lines 11-13; col 6, lines 1-3; col 10, lines 53-61)

- transmitting a product identifier for specifying upsell; (Roach: col 13, line 43 – col 14, line 9)
- receiving a selection signal indicative of whether indicating that the supplementary product upsell is accepted; and (Roach: col 13, line 43 – col 14, line 9)
- charging the upsell price to the credit account of the customer, the upsell price being in addition to the purchase price (Roach: col 10, lines 47-63)

Roach does not teach the remaining limitation. However, Deaton suggests

- determining, by a central controller, an upsell from a second merchant to offer to the customer based on the at least one purchase parameter, upsell having associated therewith an upsell price; (Deaton: col 66, line 30 – col 67, line 30)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach with the elements as taught by Deaton because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 63: Roach/Deaton discloses the limitation(s) as shown in the rejection of claim 1. Deaton further discloses the following limitation(s):

- 63. The method of claim 1, in which transmitting the product identifier for specifying the upsell comprises: transmitting, by the central controller, the product identifier for specifying the upsell. (Deaton: col 67, line 60 - col 68, line 15)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach with the elements as taught by Deaton because the claimed invention is merely a combination of

old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 75: Roach discloses the following limitation(s):

- receiving from a first merchant via a point-of-sale terminal an indication of a purchase having an associated purchase price and at least one purchase parameter; (Roach: col 5, lines 64-67)
- in which the second merchant is different than the first merchant, and in which the point-of-sale terminal is not owned or controlled by the second merchant; (Roach: col 9, lines 27-33. Roach teaches an offering of "accessories or complimentary items for the merchandise selected" and "installation services and extended warranty contracts to the customer", which implies that these products and services are from separate merchants where the second merchant does not own or control the point-of-sale terminal.)
- determining, by the central controller, whether a credit account of the customer may be charged the upsell price without exceeding a balance limit of the credit account; (Roach: col 2, lines 47-50; col 4, lines 11-13; col 6, lines 1-3; col 10, lines 53-61)
- transmitting to the point-of-sale terminal a product identifier for specifying the upsell; (Roach: col 13, line 43 – col 14, line 9)
- receiving by the central controller via the point-of-sale terminal a selection signal indicating that the upsell is accepted; and (Roach: col 13, line 43 – col 14, line 9)
- charging the upsell price to the credit account of the customer, the upsell price being in addition to the purchase price. (Roach: col 10, lines 47-63)

Roach does not teach the remaining limitation. However, Deaton suggests

- determining, by a central controller, an upsell from a second merchant to offer to the customer based on the at least one purchase parameter, the upsell having associated therewith an upsell price,; (Deaton: col 66, line 30 – col 67, line 30)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach with the elements as taught by Deaton because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 76: Humble discloses the following limitation(s):

- a processor; and a storage device in communication with the processor, the storage device storing instructions configured to direct the processor to perform steps of: (Roach: Fig:1)
- receiving from a point-of-sale terminal of a first merchant an indication of a purchase having an associated purchase price and at least one purchase parameter; (Roach: col 5, lines 64-67)
- in which the second merchant is different than the first merchant, and in which the point-of-sale terminal is not owned or controlled by the second merchant (Roach: col 9, lines 27-33. Roach teaches an offering of "accessories or complimentary items for the merchandise selected" and "installation services and extended warranty contracts to the customer", which implies that these products and services are from separate merchants where the second merchant does not own or control the point-of-sale terminal.)
- determining whether a credit account of the customer may be charged the upsell price without exceeding a balance limit of the credit account; (Roach: col 2, lines 47-50; col 4, lines 11-13; col 6, lines 1-3; col 10, lines 53-61)

- transmitting to the point-of-sale terminal a product identifier for specifying the upsell; (Roach: col 13, line 43 – col 14, line 9)
- receiving a selection signal indicating that the upsell is accepted; and (Roach: col 13, line 43 – col 14, line 9)
- charging the upsell price to the credit account of the customer, the upsell price being in addition to the purchase price. (Roach: col 10, lines 47-63)

Roach does not teach the remaining limitation. However, Deaton suggests:

- determining an upsell from a second merchant to offer to the customer based on the at least one purchase parameter, the upsell having associated therewith an upsell price,; (Deaton: col 66, line 30 – col 67, line 30)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach with the elements as taught by Deaton because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

8. Claims 64-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach/Deaton and in view of Humble (4,825,045).

Claim 64**:** Roach/Deaton discloses the limitation(s) as shown in the rejection of claim 1. Roach/Deaton does not teach the remaining limitation. However, Humble further suggests:

- 64. The method of claim 1, in which the upsell comprises an offer to the customer for a service agreement. (Humble: col 2, lines 20-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Deaton with the elements as taught by Humble because the claimed invention is merely a

combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 65: Roach/Deaton discloses the limitation(s) as shown in the rejection of claim 1. Roach/Deaton does not teach the remaining limitation. However, Humble further discloses the following limitation(s):

- 65. The method of claim 1, in which the upsell comprises an offer to the customer for a subscription. (Humble: col 2, lines 20-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Deaton with the elements as taught by Humble because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 66: Roach/Deaton discloses the limitation(s) as shown in the rejection of claim 1. Roach/Deaton does not teach the remaining limitation. However, Humble further discloses the following limitation(s):

- 66. The method of claim 1, in which the upsell comprises an offer to the customer for a discount. (Humble: col 1, lines 40-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Deaton with the elements as taught by Humble because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 67: Roach/Deaton discloses the limitation(s) as shown in the rejection of claim 1. Roach/Deaton does not teach the remaining limitation. However, Humble further discloses the following limitation(s):

- 67. The method of claim 1, in which the upsell comprises a supplementary product. (Humble: col 2, lines 20-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Deaton with the elements as taught by Humble because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 68: Roach/Deaton discloses the limitation(s) as shown in the rejection of claim 1. Roach/Deaton does not teach the remaining limitation. However, Humble further discloses the following limitation(s):

- 68. The method of claim 1, further comprising: determining a merchant financial account in dependence on the upsell; and adjusting a balance of the merchant financial account in dependence on the upsell price. (Humble: col 2, lines 15-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Deaton with the elements as taught by Humble because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 69: Roach/Deaton discloses the limitation(s) as shown in the rejection of claim 1. Roach/Deaton does not teach the remaining limitation. However, Humble further discloses the following limitation(s):

- 69. The method of claim 1, in which the at least one purchase parameter comprises a customer account identifier for specifying a customer account. (Humble: col 2, lines 15-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Deaton with the elements as taught by Humble because the claimed invention is merely a

combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 70: Roach/Deaton/Humble discloses the limitation(s) as shown in the rejection of claim 69. Deaton further suggests:

- 70. The method of claim 69, further comprising: determining, from the customer account identifier, at least one previous purchase; and in which the step of determining an upsell comprises: determining an upsell to offer based on the at least one previous purchase. (Deaton: col 66, line 30 – col 67, line 30)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Humble with the elements as taught by Deaton because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 71: Roach/Deaton/Humble discloses the limitation(s) as shown in the rejection of claim 69. Deaton further suggests:

- 71. The method of claim 69, further comprising: determining, from the customer account identifier, at least one previously- offered upsell; and in which the step of determining an upsell comprises: determining an upsell to offer based on the at least one previously-offered upsell. (Deaton: col 66, line 30 – col 67, line 30)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Humble with the elements as taught by Deaton because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 72: Roach/Deaton discloses the limitation(s) as shown in the rejection of claim 1. Roach/Deaton does not teach the remaining limitation. However, Humble further discloses the following limitation(s):

- 72. The method of claim 1, in which the at least one purchase parameter comprises a credit account identifier for specifying the credit account. (Humble: col 2, lines 15-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Deaton with the elements as taught by Humble because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 73: Roach/Deaton discloses the limitation(s) as shown in the rejection of claim 1. Roach/Deaton does not teach the remaining limitation. However, Humble further discloses the following limitation(s):

- 73. The method of claim 1, in which adjusting a balance of the financial account in dependence on the adjustment value comprises: crediting the adjustment value to the balance of the financial account. (Humble: col 2, lines 15-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Deaton with the elements as taught by Humble because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 74: Roach/Deaton discloses the limitation(s) as shown in the rejection of claim 1. Roach/Deaton does not teach the remaining limitation. However, Humble further discloses the following limitation(s):

- 74. The method of claim 1, in which adjusting a balance of the financial account in dependence on the adjustment value comprises: debiting the adjustment value from the balance of the financial account. (Humble: col 2, lines 15-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Roach/Deaton with the elements as taught by Humble because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **John Preston** whose telephone number is **571.270.3918.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ALEXANDER KALINOWSKI** can be reached at **571.272.6771**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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Examiner, Art Unit 3691
May 5, 2011

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